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January 26, 2005
Re: <u>Application No. 10/070,236 - request for reconsideration</u>

Dear Shahid Al Alam,

I would like to request that you reconsider the rejection of the claims of application 10/070,236, based on the new version of the claims which I attach.

In section (a) below I discuss the changes to the claims. Note that the references to the specification are to the original specification, rather than to the attached double spaced version. In section (b) I answer in details the objections in the action, in section (c) I discuss the novelty and non-obviousness of Claim 6. In sections (d), (e) and (f) I answer in details the rejections in the action.

I attach an abstract in a separate page as requested.
I suggest changing the title of the application to
    A system for providing limited access to parts of texts of documents.

I attach a double spaced version of the specification, which is my understanding of what is required in paragraph 4 of the action. In this version I also changed the title, but otherwise the text is identical to the original application.

(a) New claims

(a.1) The original Claim 1 was very badly written, and needed complete re-write. I therefore cancelled it, and replaced it by Claim 6. The four elements in Claim 6 (a database and three software components) are based mainly on the last three paragraphs of page 1 of the original specification.

(a.2) The database, documents and constraints are from the fifth paragraph of page 1 of the original specification. The constraints are the non-obvious part, and these are discussed at length on pages 2 and 3 of the specification.

(a.3) The first software component corresponds to the *searcher* component in the fifth paragraph on page 1 of the original specification. It is standard software.

(a.4) The second software component corresponds to the *extractor/filter* component form the fifth paragraph. The way it limits the amount of that text that it extracts is novel, and is discussed further in the last two paragraphs of page 4 and the top of page 5 of the original specification.

(a.5) The third software component corresponds to the "front-end software" from the last paragraph of page 1. It is standard software.

(a.6) The changes to the other claims are just to match the changes in terminology between the old Claim 1 and the new Claim 6, and replace "block" by "part", because it is clearer.

(B) Detailed response to the objections in the action

(b.1) **Priority** (paragraph 2 of the action) – It is not obvious to me what the "said application" refers to. The international application PCT/GB00/03503 was filed on 11 September 2000, and claimed priority from earlier application filed on 27 October 1999 (GB 9925400.5). A demand for Preliminary Examination was filed on 04 April 2001, prior to 27 May 2001, when the 19th month limit would expire. Therefore, the period for entering the national stage is 30 months and ended on 27 April 2002. The filing date of the current application is 28 February 2002, i.e. before the end of the 30 months, and therefore can claim priority from the 27 October 1999 application.

(b.2) **The abstract** (paragraph 3 of the action) – I attach abstract as requested.

(b.3) **The disclosure** (paragraph 4 of the action) – I am not sure I understood what is required in this case. I interpret the last sentence to mean that a copy of the specification with double spacing is required, and attach this. Note, however, that the references in the discussion of the claims above refer to the arrangement of the text in the original application. If the double spaced version becomes the text for further discussions, please make it clear in your response.

(b.4) **The title** (paragraph 5 of the action) – I suggest changing the title to "A system for providing limited access to parts of texts of documents".

(b.5) **Claim 1 Informalities** (paragraph 6 of the action) – As discussed above in (a), I have cancelled claim 1 and replaced it by a new claim 6, which I believe is much clearer.

(c) Novelty and non-obviousness of the claims

(c.1) The system that is described here is a solution to a different problem than the problem that is usually solved (including by Malamateniou *et al.*). The usual problem is how to allow specific users to access specific documents, but prevent them from accessing other documents. The problem that is solved in the current application is how to allow users (clients) to search the documents, but not allowing them to get the full text of the documents.

(c.2) As a result, the constraints in previous disclosures (which are typically called "authorization rules" or "permissions"), including Malamateniou *et al.*, give an answer to the question: *"Which client/user is allowed access to which document?"*. In contrast, the constraints in the current application give an answer to the question *"How much text is allowed to be extracted from this segment of this document?"*. Thus they answer a completely different question.

(c.3) In details, the elements that are novel in Claim 6 of the current application are:
  (1) Constraints that specify how much text is allowed to be extracted from each segment of the document.
       This is completely novel.
  (2) Software that extract pieces of texts that match a query from a document, and limit the amount of text to the amount specified by the constraints for the segment.
       The sequence part of this is completely novel.

(c.4) Both element (1) and the second part of element (2) are completely novel, and have

never appeared anywhere. They are non-obvious, because to think about them it is required to work out all the concept of a system for limited access to parts of the text, and that is also a concept that nobody thought about before. Thinking about this system first requires to realize the issue for publishers, and realize that it is possible to allow searches without allowing access. Thus it requires several quite non-obvious conceptual steps to think about the novel elements in Claim 6, and therefore they are not obvious.

(c.5) As explained on page 1 of the specification, for publishers to allow access to their books is costly, because clients may download them instead of buying them. On the other and, exposing the texts to searches would open many possibilities of using it, so it is a useful thing to do. The innovation of this application is making it possible to expose the texts to searches without making it possible to download them.

(c.6) Until now, everybody used the idea of authorization, in a similar way to the way it is described by Malamateniou *et al.* This is useful in the context that Malamateniou *et al.* use it, but not for publishers.

(d) Claims rejections 35 USC 112 (paragraph 7 of the action)

(d.1) I have removed the terms to which there is no sufficient antecedent basis. In particular, I cancelled claims 1, 3 and 5, and remove the reference to "server" in claim 4. I believe the new claim, claim 6, does not contain such limitations.

(d.2) In the end of this paragraph it says that it is not clear to the examiner what the applicant has contributed to the art. This was discussed above in section (c).

(e) Claim Rejections – 35 USC 101 (paragraph 8 of the action)

(e.1) I believe the new claims, in particular the new claim 6, overcome this rejection by producing a tangible and useful result, the response (pieces of texts which match the query) to the client. This is achieved by including the front-end component (third software component in claim 6) in the claims. Thus claim 6 is within the scope of what is described under the heading "Computer-Related Processes Limited to a Practical Application in the Technological Arts" in MPEP 2106 IV.b.2 (b).

(e.2) This can be seen most clearly by comparing the claim to last example in MPEP 2106 IV.b.2 (b):

> A digital *filtering* process for *removing noise from a digital signal* comprising the steps of *calculating a mathematical algorithm* to produce *a correction signal* and *subtracting the correction signal from the digital signal* to *remove the noise*

For that the current application, the analogous statement would be:

> A digital *search and extraction* process for *extracting pieces of text limited in length* comprising the steps of *searching documents in a database based on a query from a user* to produce *a list of potentially matching document* and *extracting pieces of texts from these documents which match the query and are limited in length* to *produce the response to the client.*

(e.3) The reason that this result is useful is explained in the third and fourth paragraph of the first page of the specification, and in paragraph (c.5) above.

(f) Clams rejection – 35 USC 102 (Paragraph 9 of the action)

(f.1) As explained in section (c) above, in all previous disclosures, including Malamateniou *et al.*, the constraints are associated with specific clients (users), and the constraints are about access to specific documents. In contrast, the constraints in the current application are about segments inside each document and they specify amount of text that can be extracted, they are not specific about which part of the text can be accessed and are not specific to the client,.

(f.2) In regard to the references to Malamateniou *et al.*, they disclose a database of documents and constraints, but these constraints are the typical authorization rules, and are completely different from the constraints of the current application. There is nothing about amount of text and specific segments of the documents in these authorization rules.

(f.3) Malamateniou *et al* also disclose a software component that receives queries and responds to them, which corresponds to the third software component in Claim 6, and a searcher corresponding to the first software component of the claim. However, these are not the novel and innovative parts of Claim 6. As discussed in (c) above, the novel and innovative part is what the constraints actually specify, and the second software component (*extractor/filter*). As discuss in (f.2) above, in Malamateniou *et al.* the constraints are completely different from the ones in the current application, and there is nothing in Malamateniou *et al.* that correspond to the extractor/filter.

(f.4) In the middle of page 7, the action says:" a second component which extracts from the documents that were identified by the first component pieces of texts which match the query (page 111, column 1, lines 16-22)". However, the text of this quote is from my application, and there is nothing in Malamateniou *et al.* that matches it. In page 111, column 1, Malamateniou *et al.* describe a method for optimizing the search, based on creating "signatures" for each document. However, theses "signatures" are not text, and are just a way of optimizing the search. There is noting in this column about extracting pieces of texts from the documents.

(d.12) The action then continues:"...and also checks that the amount of text in the extracts from each document does not exceed the constraints which are associated with this document (page 108, column 1 line 20 – column 2, line 26). " However, there isn't anywhere in Malamateniou *et al.* any reference to "extracts", "amounts of text" or "checking that the amount... does not exceed the constraints...", or any other terms that can be interpreted to mean the same thing. In particular, page 108 does not contain any such terms. It is all about users and roles and about authorization objects. Maybe the page number is mis-typed, but "extraction of text", "amount of text" and "checking the amount against the constraints" do not appear elsewhere in Malamateniou *et al.*, whether explicitly or by using other terms to describe the same concepts.

(d.13) Thus the main innovative features of Claim 6 do not appear at all in Malamateniou *et al.* As explained above in section (c), the change to a system as described in Claim 6 is not obvious at all, because it requires thinking about a different system that solves a different problem. Therefore Claim 6 of the current application is novel and non-obvious with respect to Malamateniou *et al.*, and Claim 6 is not anticipated by Malamateniou *et al.* or by any other preceding document.

Thanks,
Yehouda HARPAZ